
4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated July 29, 2004.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The presently claimed subject matter refers to a system (FIG 2, page 8, line 15) for exposing Internet users to advertisements together with the distribution of syndicated media content that is subject to distribution restrictions (page 9, lines 12-14 and page 10, lines 5-7). This system includes a processor (FIG 2, 202 and page 9, line 16), a memory device coupled to the processor (FIG 2, 204 and page 9, line 16), and software (FIG 2, 203 and page 9, line 15) operable on the processor 202 and memory device 204.

The software 203 causes the system to maintain a database of syndicated media content that is subject to distribution restrictions (page 10, lines 3-6, line 30, page 11, lines 1-2) and obtain a user specific set of data prior to distributing a media package to an Internet user (page 9, lines 17-19). The software means further causes the system to select a number of advertisements from a data bank containing a plurality of advertisements based on the user specific set of data in relation to the information representative of syndication broadcast agreements (page 9, lines 19-21) and combine the selected number of advertisements with a requested set of media content to form the media package (page 9, lines 23-25).

Claim 2 refers to the system of claim 1 wherein the software means is further operable to cause the system to distribute the media package to the Internet user (page 9, lines 25-27).

6. GROUNDS OF REJECTION TO BE REVIEWED

Claims 1-2 and 5-60 were rejected under 35 U.S.C. § 103(a) as being obvious over Logan et al. (US Patent No US 5,721,827) (hereinafter “Logan”)?

7. ARGUMENT

1) Applicable Law

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. In *re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). As part of establishing a *prima facie* case of obviousness, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." In *re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so."

Id. (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

"In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991))". *M.P.E.P.* § 2142.

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ

543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. In *re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). Further, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. In *re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Finally, the Examiner must avoid hindsight. In *re Bond* at 834.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill upon reading a reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. In *re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237,244 (C.C.P.A. 1969); *In re Caldwell*, 319 F. 2d 254,256, 138 USPQ 243, 245 (C.C.P.A 1963). Moreover, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP §2143.01. Additionally, the fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990).

2) The rejection of claims 1-60 under 35 U.S.C. § 103(a) as being obvious over Logan

Applicant respectfully submits that the Final Office Action has not make out a *prima facie* case of obviousness because not all of the claim elements are taught by the Logan. Applicant further submits that term “syndicated media content” must be afforded patentable weight.

Claims 1 - 2 and 5 - 60 were rejected under 35 U.S. C. 103 (a) as being obvious over Logan in paragraphs 3-5 of the Final Office Action. Applicants respectfully traverse the assertion that claim 1 is obvious over Logan. Amended claim 1 recites, “maintain a database of syndicated media content wherein the syndicated media content is subject to distribution restrictions represented in the database ...” and “select a number of advertisements from a data bank containing a plurality of advertisements based on the localizing data of the user specific set of data and the syndicated media content distribution restrictions”

In contrast, Logan provides an audio program and message distribution system in which a host system organizes and transmits programs to client locations over the Internet. Logan, Abstract; col. 1, lines 6-10, 39-46; col -2 lines 63-67. However, Logan fails to even contemplate a database that includes distribution restrictions or selecting a number of advertisements based at least in part on the distribution restrictions. This failure of Logan is clear in the Final Office Action where not such teaching is asserted to be found in Logan for the term “syndicated content” or the previously used term “syndication broadcast agreements.”

The Final Office Action states, “In general, content and agreements are nonfunctional descriptive material (MPEP 2106. IV. B.1 (b), first paragraph). ‘Syndicated content’ and ‘information representative of syndication broadcast agreements’ were accordingly not given patentable weight.” Claim 1 has been amended to clarify “syndication broadcast agreements” as “distribution restrictions.”

Applicant respectfully submits that the term “syndicated media content” must be afforded patentable weight. The syndicated media content as now claimed is subject to distribution restrictions. These distribution restrictions are used in the claim along with the user localizing data to select a number of advertisements from a databank containing a plurality of advertisements. This selecting is in accord with a functional interrelationship as described in MPEP § 2106.IV.B.1(b). Further, a claimed computer-readable medium encoded with a data structure defines structure and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory. MPEP § 2106.IV.B.1(a). Thus, because the claim defines a structural interrelationship between the syndicated media content and the localizing data provides a mechanism to select advertisements from a data bank, the claim provides more than nonfunctional, descriptive material and rises to the level of statutory subject matter.

Further, the term syndicated content is described in many locations throughout the application including at page 10, lines 6-7 and at page 24, lines 19-20. Applicant respectfully submits that these portions of the application clearly define what is meant by syndicated content such as syndicated media content.

Thus, amended claim 1 must be read to afford patentable weight to the term “syndicated media content” which is subject to distribution restrictions. By reading amended claim 1 in this manner, it is clear that claim 1 is patentable over Logan. Thus, Applicant respectfully requests reconsideration and allowance of amended independent claim 1.

The independent claims 9, 19, 30, 39, 45, 47, 48 and 56 have also been amended similarly to patentable independent claim 1. These claims further include similar elements to claim 1 and are patentable for at least the same reasons.

With specific regard to amended independent claims 9 and 39 and paragraph 11 of the Final Office Action, Applicant respectfully traverses the assertion that Logan at col. 9, lines 27-

29 teaches geographically appropriate advertisements. The cited portion of Logan instead describes associating advertisements based on subject matter categories and particular programs. Col. 9, lines 23-24. The example described in the cited portion of Logan, col. 9, lines 27-29, is along the lines of associating advertisements by subject matter categories. For example, airline advertisements associated with travelogue programs and the ads of a particular resort associated with a travelogue program discussing the region where the resort is located. This is in contrast to selecting ads based on where the requestor is located as defined by the localizing data. Thus, because Logan selects ads based on subject matter and not on localizing data of the requestor or end viewer, claims 9 and 39 are patentable over Logan.

Each of the claims 5-6, 10-11, 15-16, 20, 22-23, 38, 41-42, 44, 46, 52-55, 57-60 depend directly or indirectly from and further define the independent claims 1, 9, 19, 30, 39, 45, 47, and 48 and 51 and as such are believed allowable for the reasons set forth in support of their base claims.

Thus, Applicant respectfully requests reconsideration and allowance of claims 1-2 and 5-60.

3) Assertions of "Obvious to One of Ordinary Skill in the Art"

In paragraphs 15, 16, 17, and 18, regarding claims 6, 10-11, 20, 22, 27, 29, 38, 41, 44, and 50, the Office Action makes assertions regarding the origin and type of advertisements, means for delivery of advertisements, the use of positioning systems, and acquiring localizing data from an ISP or driver's license data as being obvious to one of ordinary skill in the art at the time of the invention. However, since all the elements of the claims are not found in the Logan reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of official notice with a single reference obviousness

rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

4) Claim Objections

Claims 54-55 and 59-60 were objected to under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim.

Applicant respectfully submits that these claims are further limiting. It appears that this objection stemmed from the failure to afford patentable weight to the term syndicated media content, as discussed above. Thus, reconsideration of claims 54-55 and 59-60 is respectfully requested.

8. SUMMARY

It is respectfully submitted that a *prima facie* case of obviousness under 35 USC 103 has not been established. Therefore, it is respectfully requested that the rejection of Claims 1-2 and 5-60 be reconsidered and withdrawn. The Applicant further submits that the Claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to contact Applicant's Attorney, Steven W. Lundberg, at 612-373-6902, if prosecution will be assisted thereby.

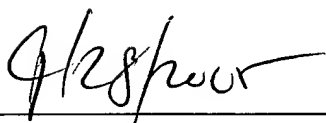
Respectfully submitted,

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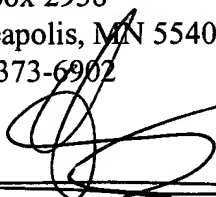
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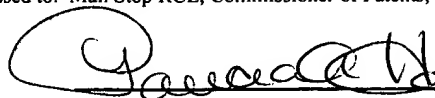


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